

Please replace the paragraph beginning at page 4, line 20, with the following replacement paragraph:

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To interrogate control codes that are selected by the actuation of buttons on movable part 20, elements 22-25 (the transponder) of movable part 20 are energized by way of an excitation oscillation produced by read unit 10. To interrogate control codes that can be generated by the actuation of buttons on movable part 20, transmission unit 12 sends to read unit 10, via antenna 11, an electromagnetic pulse (the so-called excitation oscillation) that lasts for a predefined period, in the present example approximately 50 ms. For this purpose, an oscillator 33 operating at a frequency of, for example, 125 kHz is connected for the duration of the excitation pulse (50 ms), via a switch 34 that is actuated by control unit 13 and is brought for this purpose into a first switch position 1, to a resonance oscillation circuit, comprising capacitor 32 and coil 31 acting as transmission antenna, whose resonant frequency is tuned to the frequency of oscillator 33.

#### REMARKS

Claims 9 to 14 are pending in the present application after the cancellation of Claims 15 and 16. The drawings have been amended to comply with 37 C.F.R. 1.83(a). The Specification stands objected to as containing informalities. The Specification has been amended to respond to the objection. Claim 15 has been amended. The amendments do not add new matter. Claims 9 to 16 stand rejected under 35 U.S.C. § 103(a). It is respectfully submitted that all of the presently pending claims are allowable and reconsideration of the present application is requested for at least the following reasons.

Claims 9 to 15 stand rejected under 35 U.S.C. § 103(a) as being obvious over United States Patent No. 5,838,074 to Loeffler et al. (the Loeffler reference) in view of United States Patent No. 5,625,608 to Grewe et al. (the Grewe reference). Applicant respectfully submits that Claims 9 to 14 are in condition for allowance (claim 15 having been canceled), for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art *teach or suggest each element of the claim*, but the prior art must also *suggest combining the elements in the manner contemplated by the claim*. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct.

296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See M.P.E.P. §2142. To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some *suggestion or motivation*, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, *to modify or combine the references* and that, when so modified or combined, the prior art *teaches or suggests all of the claim limitations*. See M.P.E.P. §2143. Applicant respectfully submits that these criteria for obviousness are not met here.

Independent Claim 9 recites, among other things, an arrangement for influencing an operating state of an electronic device, including ***at least one operating unit*** and a movable part for operating the electronic device and on which the at least one operating unit is arranged. The arrangement recited in Claim 9 also includes a transmission and reception device connected to the electronic device which includes a transmission unit for emitting an electromagnetic oscillation for exciting a transponder, a reception unit for receiving and demodulating a modulated electromagnetic oscillation emitted from the transponder, and an analysis unit for converting the demodulated electromagnetic oscillation emitted from the transponder into control instructions for influencing the operating state of the electronic device. In the arrangement recited in Claim 9, the code generator generates a ***plurality of codes to be selected via the at least one operating unit in order to modulate the electromagnetic oscillation emitted from the transponder***, and a plurality of further operating states of the electronic device is initiated by a selection of the plurality of codes.

Although the Examiner admits that the Loeffler reference does not teach an arrangement comprising at least one operating unit for operating an electronic device, the Examiner asserts that this feature is taught by the Grewe reference.

It is respectfully submitted that there is no suggestion in the prior art to modify the Loeffler reference in view of the Grewe reference in order to arrive at the invention of Claim 9. In In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002), the Court considered a claim directed to a method of automatically displaying functions of a video display device. In rejecting the obviousness rejection based on a combination of two references, the Court stated that the Examiner's "conclusory" statements regarding motivation to combine "do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority." Id. at 1434. According to the Court, the rejection by the Board of Appeals of the

need for any specific hint or suggestion in a particular reference amounted to an “[o]mission of a relevant factor” justifying reversal. *Id.* at 1435. The Court further added that the “common knowledge and common sense” standard on which the Board of Appeals relied, “even if assumed to derive from the agency’s expertise, [does] not substitute for authority when the law requires authority.” *Id.*

The Examiner asserts that it would have been obvious to employ in the Loeffler reference the teaching of the Grewe reference. Specifically, the Examiner states that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an arrangement comprising at least one operating unit for operating an electronic device in Loeffler et al’s device as taught by Grewe et al for the purpose of providing an enhanced and reliable remote controller.” Office Action at page 4, line 3. However, according to the Court in *In re Lee*, this type of conclusory reasoning for the modification of the applied references is insufficient to sustain an obviousness rejection. The Loeffler reference relates to an anti-theft system for a motor vehicle. The Loeffler reference gives no suggestion of the usefulness of a combination with the remote control unit for an in-home audio system discussed in the Grewe reference. Similarly, the Grewe reference provides no motivation to combine the remote control of the Grewe reference with the transponder used in the anti-theft system of the Loeffler reference. The only motivation to combine the references comes from the disclosure of the Applicant, which constitutes improper hindsight reasoning. Since there is no motivation or suggestion to combine the references, the references do not render the subject matter of Claim 9 obvious.

Furthermore, Applicant respectfully submits that neither the Loeffler reference nor the Grewe reference teaches, or even suggests, an electronic device including a code generator that generates a plurality of codes to be selected via the at least one operating unit in order to modulate the electromagnetic oscillation emitted from a transponder. The Loeffler reference apparently discusses a transponder transmitting a code word to a transceiver, while the Grewe reference apparently relates to a remote control including control buttons. But neither reference discusses, or even suggests, a code generator for generating a plurality of codes to be selected via the at least one operating unit in order to modulate the electromagnetic oscillation emitted from the transponder. In fact, since as the Examiner admits the Loeffler reference does not disclose an operating unit, and since the Grewe reference does not disclose a transponder, the combination of these references cannot disclose *a code generator for generating codes selected by an operating unit for use in modulating*

*an electromagnetic oscillation emitted from a transponder.* There is no suggestion in either the Grewe reference or the Loeffler reference of using a transponder for controlling operating states in the manner contemplated by Claim 9. Since the references cited do not disclose or suggest combining the features of Claim 9 in the manner claimed, the combination of the references cannot render obvious the subject matter of Claim 9.

Claims 10 and 11 depend from Claim 9 and are therefore allowable for at least the same reasons as Claim 9 is allowable.

Independent Claim 12 relates to an apparatus for controlling an electronic device which includes at least one operating unit arranged on a movable part and a transponder and a code generator for generating a plurality of codes. The plurality of codes are selected via the at least one operating unit in order to modulate an electromagnetic oscillation emitted from the transponder. As discussed above with respect to Claim 9, there is no suggestion or motivation to combine the Grewe reference with the Loeffler reference in the manner contemplated in Claim 12. Additionally, neither the Loeffler reference nor the Grewe reference discloses or suggests a code generator for generating a plurality of codes. Therefore, it is respectfully submitted that the references do not render Claim 12 obvious.

Claims 13 and 14 depend from Claim 12 and are therefore allowable for at least the same reasons as Claim 12 is allowable.

For at least the reasons discussed above, withdrawal of the rejections under 35 U.S.C. §103(a) with respect to Claims 9 to 14 is hereby respectfully requested.

**CONCLUSION**

Applicant respectfully submits that all of the pending claims of the present application are now in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

*Richard L. Mayer*

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By: Mary C. Weiner Reg. No. 30,333  
Richard L. Mayer  
Reg. No. 22,490

KENYON & KENYON  
One Broadway  
New York, New York 10004  
(212) 425-7200

**CUSTOMER NO. 26646**

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AMENDMENT VERSION WITH MARKINGSIN THE SPECIFICATION:

The paragraph beginning at page 3, line 7, of the specification has been amended as follows:

Transmission and reception device 10 comprises a transmission unit 12 for producing a high-frequency electromagnetic oscillation for exciting [transponder] elements 22-25 (collectively referred to as a transponder) that [is] are arranged in movable part 20 (hereinafter also referred to in abbreviated fashion as the excitation oscillation) that is emitted via the attached antenna 11. To control the transmission operations, transmission unit 12 is connected to a control unit 13.

The paragraph beginning at page 4, line 20, of the specification has been amended as follows:

To interrogate control codes that are selected by the actuation of buttons on movable part 20, [transponder] elements 22-25 (the transponder) of movable part 20 [is] are energized by way of an excitation oscillation produced by read unit 10. To interrogate control codes that can be generated by the actuation of buttons on movable part 20, transmission unit 12 sends to read unit 10, via antenna 11, an electromagnetic pulse (the so-called excitation oscillation) that lasts for a predefined period, in the present example approximately 50 ms. For this purpose, an oscillator 33 operating at a frequency of, for example, 125 kHz is connected for the duration of the excitation pulse (50 ms), via a switch 34 that is actuated by control unit 13 and is brought for this purpose into a first switch position 1, to a resonance oscillation circuit, comprising capacitor 32 and coil 31 acting as transmission antenna, whose resonant frequency is tuned to the frequency of oscillator 33.

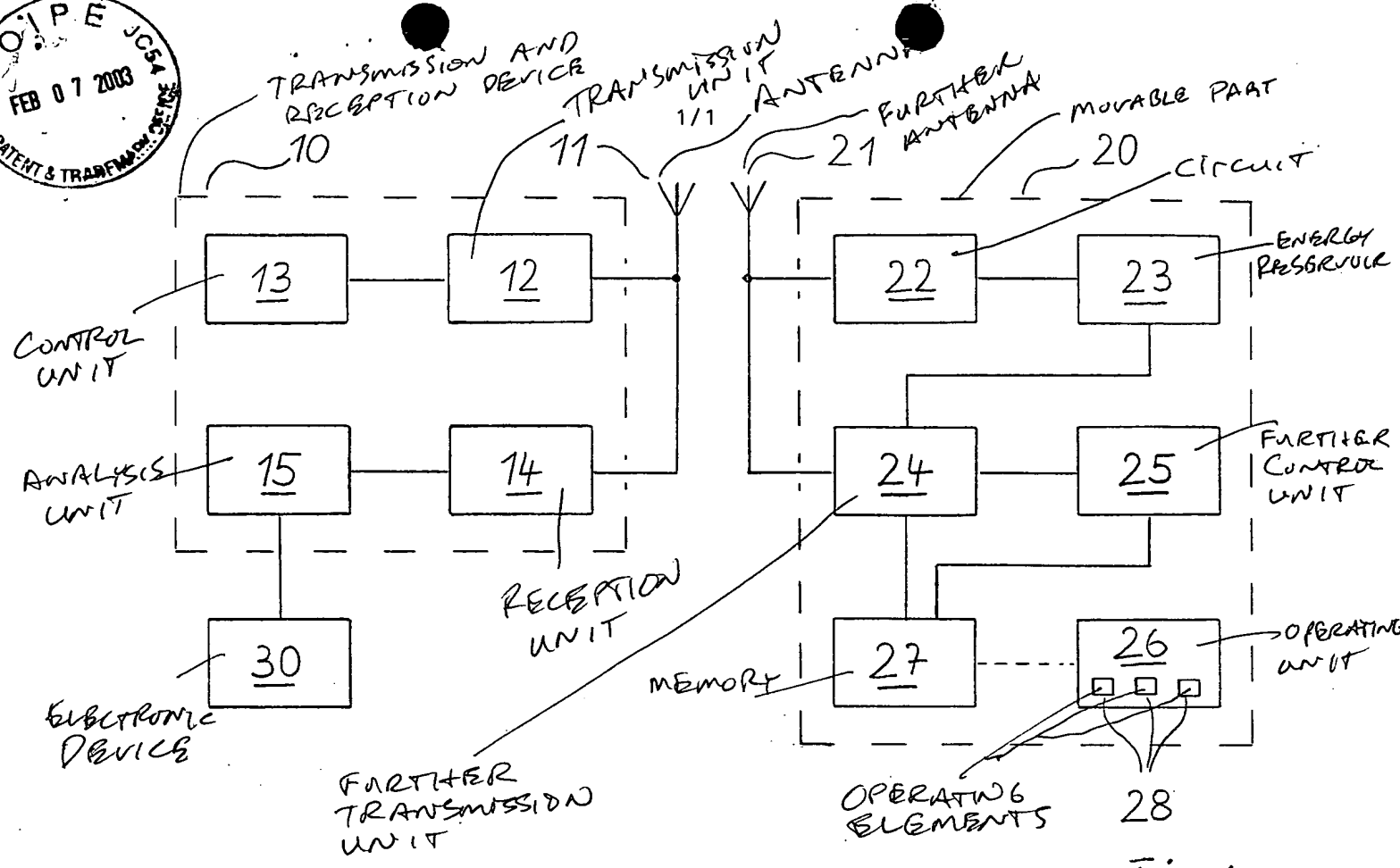


Fig. 1

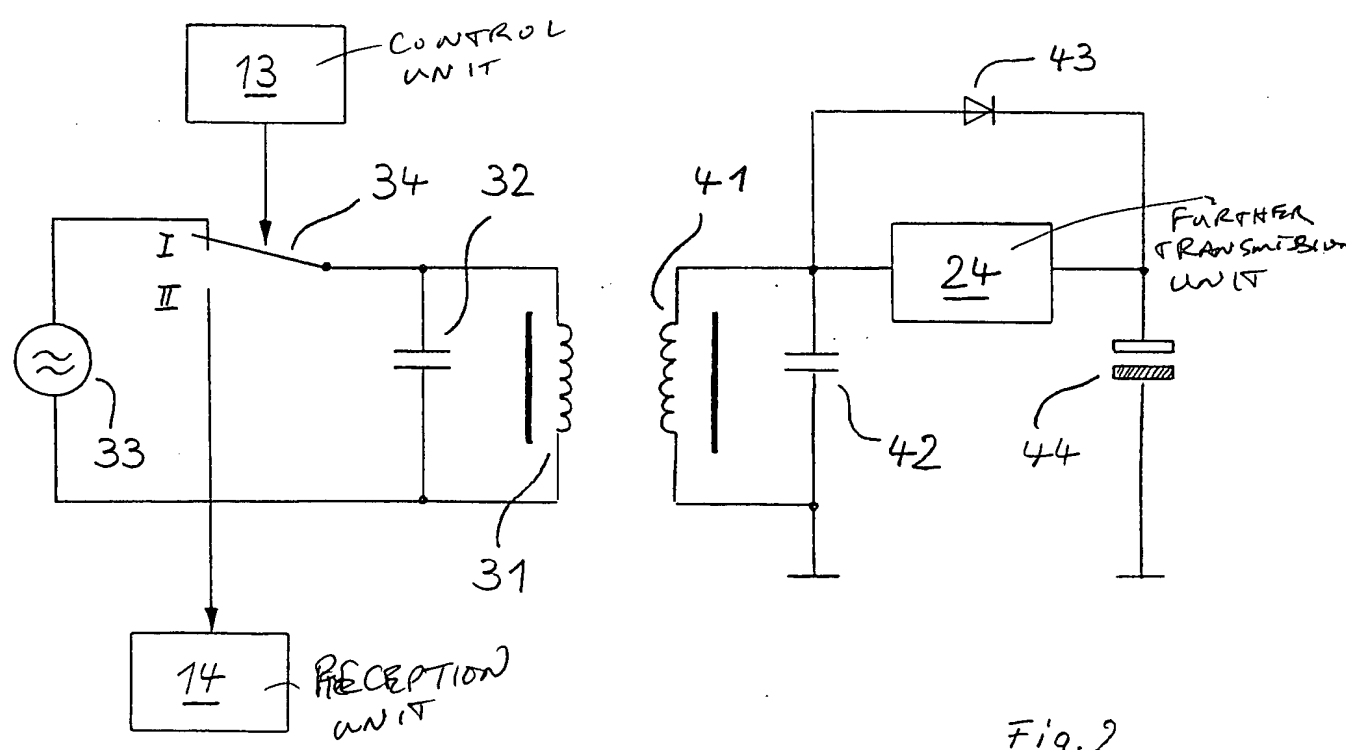


Fig. 2